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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,908	03/23/2001	Iwao Nozaki	KIT 327	6318
24972	7590	12/16/2004	EXAMINER	
FULBRIGHT & JAWORSKI, LLP			PARK, CHAN S	
666 FIFTH AVE			ART UNIT	
NEW YORK, NY 10103-3198			PAPER NUMBER	
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DATE MAILED: 12/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,908

Applicant(s)

NOZAKI, IWA0

Examiner

CHAN S PARK

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 6 and 7 are objected to because of the following informalities: perhaps "not recordable" is more appropriate for the word "unrecordable". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "said recording medium" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claim. It is not clearly understood whether this limitation is referring to "a removable recording medium" in the preamble or "a recording medium" in line 7. Also, according to the Specification, the removable recording device is never set to said input device.

Examiner understood the input device as "input 1" in fig. 2. It is not clearly understood whether the apparatus can receive digitized image data from "CD-R drive 2" or "FD drive 3". If this is the case, Examiner respectfully requests the applicant to point out such a feature from the Specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Honma U.S. Patent No. 6,476,933.

3. With respect to claim 1, Honma discloses a digital photo processing apparatus (photocopier in fig. 1) comprising:

an input device (image storing unit 304 or external interface processing unit 209 for receiving image data from host 1000 in fig. 3) for receiving digitized image data (col. 4, lines 58 – col. 5, line 8);

an image processor (both smoothing unit 305 and gamma correction unit 306 in fig. 3) for processing said image data to generate printing data (col. 5, line 55 – col. 6, line 4);

a digital printer (printer unit 204) for making photo prints from said printing data;
and

a data recorder for recording said printing data used by said digital printer on a removable recording medium (hard disk 304b in col. 13, lines 61-63), said data recorder

including a resolution converter for automatically converting the printing data to a proper resolution corresponding to a resolution of said digital printer (col. 9, lines 64-14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honma as applied to claim 1 above, and further in view of Shimura et al. U.S. Patent No. 6,215,260 (hereinafter Shimura).

4. With respect to claim 2, Honma discloses the digital photo processing apparatus as defined in claim 1, wherein said data recorder further includes a capacity checker for detecting an available capacity of said removable recording medium (col. 10, lines 1-7) but Honma does not disclose expressly that the resolution converter for converting the resolution of the print data when the printing data has a volume exceeding said available capacity detected by said capacity checker.

Shimura, the same field of endeavor of the digital image printing, discloses a digital photo processing apparatus comprising;

an input device (input unit 3 in fig. 1) for receiving digitized image data;

an image processor for processing said image data to generate printing data (col. 2, lines 12-13);

a digital printer (print mechanism 8) for making photo prints from said printing data; and

a resolution converter for converting the image data when the image data has a volume exceeding an available capacity of a memory detected by a capacity checker (col. 3, lines 22-32).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the resolution converter of Shimura into the data recorder of Honma.

The suggestion/motivation for doing so would have been to facilitate the effective use of the removable recording medium (col. 5, lines 17-21 of Honma). By detecting the size of the print data to be stored in the removable recording medium and the size of the available capacity of the removable recording medium and one would have been motivated to convert the print data to a lower resolution to effectively use the remaining available memory area of the removable recording medium.

Therefore, it would have been obvious to combine Honma with Shimura to obtain the invention as specified in claim 2.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honma as applied to claim 1 above, and further in view of Osawa et al. U.S. Patent No. 6,552,819 (hereinafter Osawa).

5. With respect to claim 3, Honma discloses the digital photo processing apparatus as defined in claim 1, but Honma does not disclose expressly the data recorder

including a data compressor for compressing said printing data having the resolution converted.

Osawa, the same field of endeavor of the digital image printing, teaches the method of detecting the size of the input data and the size of image memory and the method of converting image data to lower resolution and further compressing the converted data to increase the memory efficiency (col. 7, lines 1-35 and fig. 2).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the method of compressing the already resolution converted image data of Osawa into the digital image printing method of Honma.

The suggestion/motivation for doing so would have been to further increase the efficiency of the memory size by the compression.

Therefore, it would have been obvious to combine Honma with Osawa to obtain the invention as specified in claim 3.

6. With respect to claim 4, Osawa further discloses the digital photo processing apparatus wherein the compressor is operable with a compression ratio automatically set from a relationship between a volume of said printing data to be compressed and the available capacity of said removable recording medium (col. 7, lines 4-26).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honma as applied to claim 1 above, and further in view of Kinjo U.S. Patent No. 6,504,620.

7. With respect to claim 5, Honma discloses the digital photo processing apparatus as defined in claim 1, but Honma does not disclose expressly an attribute data

processor for generating order attribute data such as a customer name and a customer address to be recorded along with said printing data on said removable recording medium.

Kinjo, the same field of endeavor of digital image printing, discloses an attribute data processor for generating order attribute data such as a customer name and a customer address to be recorded along with said printing data on said removable recording medium (col. 5, lines 13-16 & col. 13, lines 20-21).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the attribute data processor of Kinjo into the digital photo processing apparatus of Honma.

The suggestion/motivation for doing so would have been to correctly identify each individual client using client ID at the digital image printing apparatus (col. 13, lines 17-19 of Kinjo).

Therefore, it would have been obvious to combine Honma with Kinjo to obtain the invention as specified in claim 5.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honma in view of Shimura.

8. With respect to claim 6, Honma discloses a digital photo processing apparatus having an input device for receiving digitized image data, an image processor for processing said image data to generate printing data, and a digital printer for making photo prints from said printing data, and Honma further teaches a method of recording

said printing data used by said digital printer on a removable recording medium, comprising the steps of:

checking an available writing capacity of the recordable recording medium (col. 10, lines 1-7); and

converting a resolution of said printing data without substantially lowering image quality (col. 10, lines 1-7).

Also, refer to the arguments presented for claim 1.

Honma, however, does not disclose expressly a method for comparing said available writing capacity detected and a volume of said printing data to be recorded and a method for converting a resolution when said printing data is not recordable on said removable recording medium.

Shimura, the same field of endeavor of the digital image printing, discloses a digital photo processing apparatus comprising;

an input device (input unit 3 in fig. 1) for receiving digitized image data;

an image processor for processing said image data to generate printing data (col. 2, lines 12-13);

a digital printer (print mechanism 8) for making photo prints from said printing data; and

a resolution converter for converting the image data when the image data has a volume exceeding an available capacity of a memory detected by a capacity checker (col. 3, lines 22-32).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the resolution converter of Shimura into the data recorder of Honma.

The suggestion/motivation for doing so would have been to facilitate the effective use of the removable recording medium (col. 5, lines 17-21 of Honma). By detecting the size of the print data to be stored in the removable recording medium and the size of the available capacity of the removable recording medium and one would have been motivated to convert the print data to a lower resolution to effectively use the remaining available memory area of the removable recording medium.

Therefore, it would have been obvious to combine Honma with Shimura to obtain the invention as specified in claim 6.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Honma and Shimura as applied to claim 6 above, and further in view of Osawa.

9. With respect to claim 7, the combination of Honma and Shimura teaches the method as defined in claim 6 but it does not teach expressly a step of compressing said printing data with a compression ratio for enabling recording of said printing data on said recording medium, when said printing data remains not recordable on said recording medium after the resolution is converted.

Osawa, the same field of endeavor of the digital image printing, teaches the method of detecting the size of the input data and the size of image memory and the

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method of converting image data to lower resolution and further compressing the converted data to increase the memory efficiency (col. 7, lines 1-35 and fig. 2).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the method of compressing the already resolution converted image data of Osawa into the digital image printing method of Honma and Shimura.

Since the size of the resolution converted image data can be further reduced by the compression and thus increases the memory efficiency, one would have been motivated to combine the three references to increase the memory efficiency when the converting a resolution image data does not resolve the insufficiency memory situation (col. 7, lines 22-23 of Osawa).

Therefore, it would have been obvious to combine Honma and Shimura with Osawa to obtain the invention as specified in claim 7.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Honma and Shimura as applied to claim 6 above, and further in view of Kinjo.

10. With respect to claim 8, the combination of Honma and Shimura teaches the method as defined in claim 6, but it does not teach expressly a step of recording order attribute data such as a customer name and a customer address on said removable recording medium.

Kinjo, the same field of endeavor of digital image printing, discloses an attribute data processor for generating order attribute data such as a customer name and a

customer address to be recorded along with said printing data on said removable recording medium (col. 5, lines 13-16 & col. 13, lines 20-21).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the attribute data processor of Kinjo into the digital photo processing apparatus of Honma and Shimura.

The suggestion/motivation for doing so would have been to correctly identify each individual client using client ID at the digital image printing apparatus (col. 13, lines 17-19 of Kinjo).

Therefore, it would have been obvious to combine Honma and Shimura with Kinjo to obtain the invention as specified in claim 8.

Conclusion

11. Examiner kindly requests the applicant to provide a reference that teaches the limitation cited on page 2, lines 10-15 of the Specification.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park
Examiner
Art Unit 2622

csp
December 10, 2004


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